



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,866	12/06/2001	Vijay Kumar	P04829US1	6560

22885 7590 05/16/2006

MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
----------	--------------

1623

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED
MAY 16 2006
GROUP 1600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/007,866
Filing Date: December 06, 2001
Appellant(s): KUMAR ET AL.

Wendy K. Marsh
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 13, 2006 appealing from the Office action mailed November 1, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of Claim 36 under 35 U.S.C. 102(b) has been withdrawn in view of the amendment to the claim filed August 25, 2005.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Appellant amended Claim 36 by incorporating into the claim the text "said biodegradable oxidized cellulose ester having an acid number of at least 133". Appellant points to Example 1, page 13, line 26 of the instant specification for support of this amendment to Claim 36 wherein it states the starting material for synthesis of the compound in the example has a carboxylic content of 13.7%. Appellant argues that the resulting compound has a carboxylic content of 10.57%, which converts to an acid number of 133.9. However, the conversion of the carboxylic content 10.57% to an acid number of 133.9 in Example 1 is insufficient documentation for support of claim limitation since Example 1 in the instant specification does not disclose the carboxylic content of the resulting compound thereof and does not set forth the acid number of the resulting compound. Accordingly, the amendment of Claim 36 to set forth the acid number of the claimed oxidized cellulose ester thereof sets forth new matter, which is improper and fails to comply with the written description requirement of the first paragraph of 35 U.S.C. 112.

(10) Response to Argument

A. *Rejection Under 35 USC § 112, First Paragraph*

Appellant argues against this rejection on the ground that the acid number of Appellant's claimed compounds merely identifies an inherent characteristic of the preferred compounds specifically described in Example 1 of the original disclosure. This argument is not persuasive because the first paragraph of 35 USC § 112 requires that the specification to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Not only does the instant specification not recite the acid number of a compound disclosed in the specification, including Example 1, but does not mentioned the term "acid number" anywhere in the original application. Appellant argue that it was pointed out in Example 1 of the instant specification that the starting material for synthesis of the compound (oxidized cellulose acetate) in the example has a carboxylic content of 13.7%, which was noted. However, Appellant then disclosed that the resulting oxidized cellulose acetate produced in Example 1 has a carboxylic content of 10.57%, which is not supported in the instant specification. It appears that this unsupported carboxylic content of 10.57% is used to determine the acid number of the instantly claimed oxidized cellulose ester, which is recited as an acid number of at least 133. Not only is the acid number of 133 for the instantly claimed oxidized cellulose ester not supported in the instant specification, but the carboxylic content of 10.57% from which the acid number is calculated is not supported in the instant specification.

It is also noted that only the carboxylic content of the starting oxidized cellulose compounds are disclosed in the instant specification. The carboxylic content of 10.57% used by Appellant to obtain the acid number of 133 is based on the carboxylic content of a final product (oxidized cellulose ester). Appellant does not disclose the carboxylic content of any final product (cellulose ester) in the instant specification.


It is further noted that instant Claim 36 recites "oxidized cellulose ester having an acid number of at least 133". Claim 36 does not disclose an upper limit for the acid number. Hence, the instantly claimed acid number for oxidized cellulose ester having values greater than 133 is not supported in the instant specification. Accordingly, the rejection of instant Claim 36 for disclosing new matter should be maintained for the reasons of record.

(11) Related Proceeding(s) Appendix

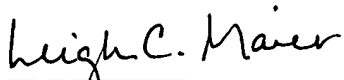
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Everett White
Examiner
Technology Center 1600

Conferees:


Leigh Maier
Primary Examiner
Technology Center 1600


Shaojia A. Jiang
Supervisory Primary Examiner
Technology Center 1600